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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,246	09/05/1997	MICHAEL J SULLIVAN	SLD-2035-1-2	6680

24492 7590 10/31/2003

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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 37

Application Number: 08/926,246
Filing Date: September 05, 1997
Appellant(s): SULLIVAN, MICHAEL J

Richard M. Klein
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 31 2003
GROUP 3700

This is in response to the appeal brief filed 6/5/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct for the application as of the date of 9/5/97 when the instant claims were filed. The specification in light of these claims defines the invention as described. However, the specification alone which seeks to preserve a priority date of 6/1/93 does not support a golf ball as described in the Summary of Invention. The values recited by the applicant as being found on the various pages are simply not present. As an example the core diameter found on page 35, lines 12-14 is "about 1.495 to about 1.575 inches" (37.973mm to 40.005mm) and not "at least 29mm "1.1417" inches as asserted in the "Summary of the Invention". Applicant's "at least 29mm" recitation in the "Summary of the Invention" includes the values from 29mm through at least 37.973mm and these values are not found in the passage cited by the applicant or anywhere else in the specification.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The primary issue in this is appeal is what priority date appellant's claims are entitled to. The application as

filed seeks a priority date of 6/1/93 for the instant claims. It is the examiner's position that the instant claims are only entitled to a priority date of 9/5/97 when they were first filed.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because no reasons are given as to why claims 2 and 4 are separately patentable. Therefore claims 2 and 4 are considered to stand or fall with claim 1.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

633,043	Higuchi	1-1995
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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 29.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Higuchi '043. This rejection is set forth in prior Office action, Paper No. 29.

(11) *Response to Argument*

The primary issue present in this appeal is what priority date appellant is entitled to for claims 1-8. It is appellant's position that support for the claims may be found in the specification, which dates through a chain of applications to 6/1/93. Appellant's arguments are all based on the premise that the specification alone enables the claims filed 9/5/97. The

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examiner takes the position that the earliest possible priority date for claims 1-8 is 9/5/97 - the date the claims were filed in the instant application. Therefore the application is properly a CIP with the subject matter of claims 1-8 being the "in part" part of the application.

Appellant's response to the claim 1 rejection is that although the appellant is claiming a range from 29 mm to infinity, and that the lowest value the disclosure recites is 39.243 mm he has nevertheless enabled the range which includes 29mm - 39mm. The 39 mm value recited by the appellant is approximately 30% larger than the lower end of the claimed range and nothing in the specification indicates that appellant intended to include anything below 39.243 mm as opposed to other possibilities.

The same logic applies to the range of the specific gravity of the core between 1.4 and 1.155. Appellant has simply given no indication that specific gravities in this range were intended to be part of his invention.

Regarding the lower limit of the intermediate thickness, appellant is correct in that this was part of the original disclosure. However, appellant's disclosed ball is not inclusive of thicknesses above 2.54mm whereas that being claimed is. Appellant's assertions with regard to the '852 patent are conclusive of nothing. The application which matured into the '852 patent disclosed the claimed range, "at least 1 mm" whereas appellant's application did not. Appellant is reminded that the original disclosure includes what was included in the original specification, abstract, claims, and drawings and not merely the original specification. Moreover, even were it the case that the '852 patent was not enabled, the proper course of action would not be to issue a second application which was not enabled.

Concerning the specific gravity of the intermediate layer, the originally filed disclosure is not inclusive of the range between 1.2 and .97 as is now being claimed. Appellant's exhibit A (resubmitted as exhibit B) does not address any specific gravities between 1.2 and .99.

Appellant's assertion that these exhibits reasonably convey a specific gravity of "less than 1.2" is not supported. Why would these exhibits support "less than 1.2" more than "less than 1.0?"

Appellant's 1.2 figure for the upper end of the range is but one possibility among many with no support for any particular value. The 1.2 value derives solely from the '852 patent. Concerning what is included in the '852 patent's original disclosure note the examiner's above comments.

With regard to the hardness of the intermediate layer, the originally filed disclosure is not inclusive of the range between 85 and 95. Appellant asserts that the recitation in the specification of 96 or 98 means "at least 85". Again there is not support for this assertion and it is but one possibility among others.

Concerning the appellant's outer cover thickness, the largest cover thickness originally disclosed was 1.27 mm which is *not even half* of the now claimed 3 mm.

In response to appellant's claim 3 arguments, the appellant freely admits that there would have been possibilities other than that which he now claims. Moreover, how would one know that appellant intended the entire range as opposed to only an upper end of the range? Even using appellant's logic, at best a range of 60-80 on JIS C scale has been disclosed. Concerning the core hardness no support whatsoever is offered for the claimed range. Appellant's entire argument is that it would have been "inherent." The question is, "Inherent based on what?"

Regarding the claim 5 arguments, appellant has provided no evidence that a lower limit of 29 mm was disclosed to the exclusion of other possibilities. Why would 35.052mm reasonably enable 29mm and not 31mm as the lower limit on the core diameter?

Regarding claim 6, appellant has still provided no evidence that values above .234 or below .164 were intended as is now claimed. Thus, values outside of this range are not enabled by the specification. Even were values outside this range intended how would one know what they were?

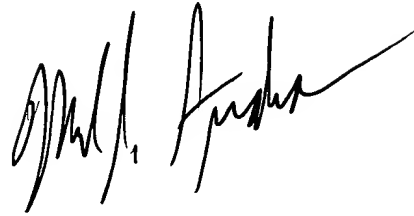
Likewise, with regard to claims 7 and 8, appellant has still provided no evidence that values as high as the upper end of the claimed ranges, or as low as the lower end of the claimed ranges were intended as is now claimed. Thus, values such as these are not enabled. The values now being claimed are only one possibility among an infinite number that appellant might have intended. Appellant focuses on the fact that he has disclosed values within these ranges. However, that is not the issue. The issue is what values other than those disclosed are enabled. To this end appellant can provide no evidence that he intended values as high or as low as those now claimed.

In response to appellant's arguments concerning the 35 U.S.C. 102(b) rejection based on Higuchi it is noted that appellant has no disagreement with the substance of the rejection. The only issue is whether Higuchi is available as prior art. For the reasons explained above the instant claims are only entitled to a priority date of 9/5/97. Therefore, Higuchi's 1/11/95 date qualifies it as prior art under 35 U.S.C. 102(b) and the rejection must be sustained.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

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Primary Examiner
Art Unit 3711



October 24, 2003

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